REMARKS

Claims 1-3, 5-12, 14-23 and 25-29 are pending in the present application. No claims were canceled; no claims were amended; and no claims were added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. §103, Alleged Obviousness, Claims 1, 11, and 21

The Examiner has rejected claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Admitted Prior Art* (AAPA) in view of *Eerola* (U.S. Patent No. 6,678,518). This rejection is respectfully traversed.

With regard to independent claim 1, the Examiner has stated:

> As to claim 1, AAPA discloses the invention substantially as claimed, including a method of formatting (customizing) content data for presentation on a client device (510, fig. 5) (i.e. transcoding is the process of customizing data content . . . transcoding is performed for a variety of reasons including meeting the unique presentation requirements of a particular type of client device, specification, page 1, lines 9-21), comprising:
>
> receiving a request for content data (i.e., HTTP Request, fig. 5; when a client device sends a content request to a server; specification, page 1, lines 22-23), the request having client device characteristic information (i.e., the request header includes information identifying the device type, user identification, passwords, URL requested, HTTP method used; specification, page 1, line 24 – page 2, line 8);
>
> storing the client device characteristic information (i.e., This header data is passed by the web server to the content generator; specification, page 2, lines 4-5; HTTP request is passed to a servlet engine, 530, fig. 2, specification, page 2, lines 24-27);
>
> generating generic content data (i.e., content generator servlet, 540, fig. 5; the retrieved content is passed to a transcoding servlet, 550, fig. 5 as generic HTML; specification, page 2, lines 24-27); and
>
> transcoding said generic content data to produce transcoded content data (i.e., transcoding servlet, 550, fig. 5; the transcoding servlet, 550, fig. 5 transcodes the generic HTML; specification, page 3, lines 1-3).
>
> AAPA discloses transcoding is performed for meeting the unique presentation requirements of a particular type of client device, a particular user, or a particular kind of connection (specification, page 1, lines 9-21). However, AAPA does not specifically disclose transcoding using said client device characteristic information. Eerola discloses transcoding using said client device characteristic information (i.e., servlets are configured to perform content conversion (i.e., transcoding) so as to adapt

> the requested content in accordance with user preferences (i.e., user device characteristics), to optimize the content to a user device, to perform graphics conversions, or to automatically translate from one language to another, col.2, lines 4-17; administrator module, 20, fig. 2 receives the request and identifies one or more servlets 22, 24, fig. 2 for processing the request based on the characteristics or parameters of the URL request (i.e., client device characteristic information); col. 4, lines 40-49; the servlet 24, fig. 2 sends a response including a MIME header containing information indicating the content type of the requested resource; col. 4, lines 49-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of AAPA and Smith because Eerola's transcoding servlet would improve delivery speed and accessibility of content data by performing content conversion so as to adapt the requested content data in accordance with user preferences (Eerola, col.2, line 13-17; col. 4, lines 49-56).

(*Office Action*, dated October 1, 2004, pages 3-5).

Independent claim 1, which is representative of independent claims 11 and 21 with regard to similarly recited subject matter, reads as follows:

> 1. A method of formatting content data for presentation on a client device, comprising:
> receiving a request for content data, the request having client device characteristic information;
> storing the client device characteristic information;
> generating the content data; and
> transcoding the content data using the client device characteristic information to produce transcoded content data.

The Examiner bears the burden of establishing a prima facie case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). For an invention to be prima facie obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The *Applicant's Admitted Prior Art* reference cited by the Examiner does not render obvious the present invention as recited in independent claims 1, 11, and 21 because the references fail to teach or suggest all claim limitations.

These rejected independent claims all recite storing client device characteristic information and transcoding based upon the client device characteristic information. Claim 1 recites "storing the client device characteristic information . . . and transcoding

the content data using the client device characteristic information to produce transcoded content data." Storing client device characteristic information and transcoding based upon the client device characteristic information are features not taught or suggested in *Applicant's Admitted Prior Art* or any of the other references.

Applicant's Admitted Prior Art is directed towards transcoding as the process of customizing data content, but not transcoding based upon the stored client device characteristic information from any particular client's request, as recited in claim 1 of the present invention. In the Office Action, the Examiner alleges that in the following cited passages *Applicant's Admitted Prior Art* teaches storing client device characteristic information.

> or POST), and the like. This header data is passed by the webserver to the content generator process but is

(Specification, page 2, lines 4-5).

> Web server 520. The HTTP request is passed to a servlet engine 530 which invokes a content generator servlet 540, passing the request information. The retrieved content is passed to a transcoding servlet 550 as generic HTML.

(Specification, page 2, lines 24-27).

On pages 3, 6, and 7, the Office Action references the Specification from page 1 line 24 to page 2 line 8, a citation that includes the full sentence referenced above by page 2 lines 4 to 5. The full sentence on page 2 line 4 to page 2 line 8 reads as follows:

> This header data is passed by the webserver to the content generator process but is not passed on the way to subsequent steps in the remaining output path on the way to the requesting device, such as to the transcoding mechanism. (Emphasis added).

Not taking into account the clarifying clause of the full sentence resulted in the inaccurate allegation that the *Applicant's Admitted Prior Art* teaches storing client device characteristic information as recited in claim 1 of the present invention. *Applicant's Admitted Prior Art* teaches passing header data "by the webserver to the content generator process" but not to "subsequent steps in the remaining output path on the way to the requesting device, such as the transcoding mechanism." (Specification, page 2, lines 4-8). Although *Applicant's Admitted Prior Art* teaches receiving a request for

content data, generating the content data, and transcoding the content data, *Applicant's Admitted Prior Art* does not teach or suggest storing the client device characteristic information or using the client device characteristic information to produce transcoded content data as recited in claim 1 of the present invention.

While the *Applicant's Admitted Prior Art* teaches a transcoding servlet that transcodes the generic HTML, this transcoding does not use the client device characteristic information as recited in claim 1 of the present invention. Because the *Applicant's Admitted Prior Art* does not store client device characteristic information or use client device characteristic information for transcoding, "transcoding is limited to a fixed manipulation which can not react to the client device characteristics." (Specification, page 2, lines 10-12). This failure to store client device characteristic information and use client device characteristic information in the transcoding process results in clients being limited to "requesting data from content sources that are formatted for the particular type of client device." (Specification, page 2, lines 13-14).

As an additional reason for rejecting claim 11, the Office Action alleges that the *Applicant's Admitted Prior Art* discloses that "the preamble servlet stores the client device characteristic information in a data structure (i.e., This header data is passed by the web sever to the content generator; specification, page 2, lines 4-5; HTTP request is passed to a servlet engine, 530, fig. 2, specification, page 2, lines 24-27)." (*Office Action*, dated October 1, 2004, page 7). The Specification does not indicate that the prior art discloses that the client device characteristic is stored in a data structure of any kind, and even indicates that after the client device characteristic is passed to (not stored by) the content generator process, it "is not passed on to the subsequent steps on the way to the remaining output device, such as to the transcoding mechanism." (Specification, page 2, lines 5-8).

In fact *Applicant's Admitted Prior Art* makes no mention of storing the client device characteristic information contained in the header data for any use. Although *Applicant's Admitted Prior Art* teaches that the header data is passed by the webserver to a servlet engine to invoke a content generator servlet, the header data is never stored for use by "subsequent steps in the remaining output path on the way to the requesting device, such as to the transcoding mechanism." (Specification, page 2, lines 6-8).

The Examiner further states on page 4 of the Office Action that it would be obvious to combine *Applicant's Admitted Prior Art* with *Smith* and *Eerola* to arrive at the features of the claimed invention. However, *Smith* does not cure the deficiencies in *Applicant's Admitted Prior Art*. As discussed in the Abstract, *Smith* is directed towards a system that "utilizes transcoding policies based on content classes," not based upon the client device characteristic information as recited in claim 1 of the present invention. *Smith* teaches "real-time, on-line transcoding" based upon image features that are "extracted only as needed for the tests in order to minimize processing. The image features are derived from several color and texture measures computed from the images." (*Smith*, page 2, § 2.1. Image type classification). *Smith* does not teach or suggest the storage of client device characteristic information or usage of client device characteristic information for transcoding content data as recited in claim 1 of the present invention.

Eerola does not cure the deficiencies in *Applicant's Admitted Prior Art* and *Smith*. Applicants agree with the Office Action that *Applicant's Admitted Prior Art* does not disclose transcoding using said client device characteristic information. Although *Eerola* does teach transcoding in accordance with "user preferences" and "optimizing the content to a user device,"(*Eerola*, Column 2, lines 14-15). *Eerola* also does not teach or suggest the storage of client device characteristic information or usage of client device character information for transcoding content data, as recited in claim 1 of the present invention. "User preferences" are not client device characteristic information, but application or system options that allow users to customize their working environment. For example, a document-based application may store user preferences for the default font, automatic save options, or page setup information.

In contrast, client device characteristic information is not set by the user. Applicant's Specification lists an example of client device characteristic information that is device dependent, not a user preference, "a small handheld computer (PC), with a screen capable of only showing gray scale." (Specification, page 2, lines 19-20). The client device characteristic information for such a PC will indicate that this particular client device has a screen capable of showing gray scale, information that is not indicated by any user preferences.

While *Eerola* does teach transcoding in accordance with "optimizing the content to a user device," (*Eerola*, column 2, line 15). *Eerola* still does not teach the storage of client device character information or usage of client device character information for transcoding content data, as recited in claim 1 of the present invention. *Eerola* teaches the more limited use of "at least one Java content conversion servlet for converting the content type of the received requested resource to a different content type." (*Eerola*, column 6, lines 43-45; the other independent claims have almost identical clauses). In fact, *Eerola* teaches that these and other servlets loop continuously, performing a wide variety of conversions, including those already mentioned and those "to perform graphics conversions, or to automatically translate from one language to another." (*Eerola*, column 2, lines 15-17). In contrast to the present invention transcoding content based on client device characteristic information, *Eerola* teaches "the servlets. . . format the type of content (e.g., text, image, audio, video, message, etc.) received from the origin server. (*Eerola*, column 4, lines 18-22).

Even though the *Eerola* servlets perform a variety of specified functions, *Eerola* never mentions the use of client device characteristic information from the header data. If one of these servlets converts content data from a content source that is formatted for the particular type of requesting client device, then that servlet has been optimizing the content for the requesting user device. However, if the content data is from a content source that has not been formatted for the particular type of requesting client device, then the servlets may have been optimizing the content for some other user devices, but no servlet has optimized the content for the particular requesting user device. In contrast, the present invention provides "client device characteristic information to a transcoding servlet in order to customize data content for presentation on the client device. (Specification, page 3, lines 13-16).

Furthermore, the Office Action inaccurately equated *Eerola's* "processing the request based on the characteristic or parameters of the URL request" with the "client device characteristic information" of the present invention. (*Office Action*, page 4, quoting in part *Eerola*, column 4, lines 42-44). The Applicant's specification discloses that the "request header typically includes information identifying the device type, user identification, passwords, [and] uniform resource locater (URL) requested," but does not

equate the device type with the parameters of the uniform resource locater requested, for this information is not the same. (Specification, page 1 line 24 – page 2 line 2).

As an additional reason for rejecting claim 21, the Examiner indicates that the *Applicant's Admitted Prior Art* discloses "a computer program product . . . for formatting content data for presentation on a client device. . . and displaying said content on said client device." (*Office Action*, dated October 1, 2004, page 8). The Office Action fails to take into account not only the feature in claim 21 that specifies "storing the client device characteristic information," but also the limitation specifying the computer program product's "instructions for transcoding the content data using the client device characteristic information to produce transcoded data." As discussed above, unique features of the present invention include the storing of client device characteristic information and using of client device characteristic information in transcoding content data for presentation on a particular client device. Because *Applicant's Admitted Prior Art* lacks this feature, it does not render the features in claim 21 obvious.

Even if *Applicant's Admitted Prior Art* were combinable with *Smith* and/or *Eerola*, the result of such a combination would not be the invention as recited in independent claim 1. Rather, such an alleged combination would result in a transcoding system, substantially as taught in *Applicant's Admitted Prior Art*, using servlets in the manner described by *Eerola*, with the content images tested and transcoded in the manner described in *Smith*. Even with the alleged additions of *Applicant's Admitted Prior Art*, *Smith* and *Eerola*, there would be no ability for the storing of client device characteristic information or for using the client device characteristic information to produce transcoded content data as recited in claim 1 of the present invention.

Furthermore, there is no teaching or suggestion in the references as to the desirability of including the features from other references. The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also *see In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a

suggestion of the desirability of the proposed modification. The only motivation to even to attempt to combine *Applicant's Admitted Prior Art, Smith* and *Eerola* is to try to arrive at Applicant's claimed invention and thus, the alleged combination is a result of impermissible hindsight reconstruction using Applicant's own disclosure as a guide. While Applicant understands that all examination entails some measure of hindsight, when the rejection is based completely on hindsight, as in the present case, rather than only what is gleaned from the references, then the rejection is improper and should be withdrawn.

In view of the above, Applicant submits that independent claims 1, 11, and 21 are not taught or suggested by the alleged combination of *Applicant's Admitted Prior Art, Smith,* and *Eerola*. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 11, and 21 under 35 U.S.C. §103.

II. 35 U.S.C. §103, Alleged Obviousness, Claims 2, 12, and 22

The Examiner has rejected claims 2, 12, and 22 under 35 U.S.C. § 103 (a) as being unpatentable over *Applicant's Admitted Prior Art* in view of *Eerola* (U.S. Patent No. 6,678,518). This rejection is respectfully traversed.

The Office Action alleges that *Applicant's Admitted Prior Art* discloses "wherein the transcoding servlet obtains the client device information from the preamble servlet (i.e., servlet engine 530, fig. 5; the HTTP request is passed to a servlet engine which invokes a content generator servlet 540, passing the request information. The retrieved content is passed to a transcoding servlet 550; specification, page 2, lines 24-27)." (*Office Action*, dated October 1, 2004, page 5). But this allegation overlooks the Specification's clear indication that the client device characteristic information in the "header data is passed by the webserver to the content generator process, but is not passed on to subsequent steps on the way to the requesting device, such as to the transcoding mechanism." (Specification, page 2, lines 4-8). Thus, while the client device characteristic information is part of the "HTTP request [that] is passed to a servlet engine 530 which invokes a content generator servlet 540, passing the request information," the "retrieved content [that] is passed to a transcoding servlet 550 as generic HTML" does not include the client device characteristic information. (Specification, page 2, lines 24-27). Claim 2, which is

representative of dependent claims 12 and 22 with respect to similarly recited subject matter, specifies a preamble servlet performing the step of storing the client device characteristic information. Because Applicant's *Admitted Prior Art* does not teach or suggest storing client device characteristic information, it does not render claims 2, 12 or 22 obvious.

Additionally, Claim 2 is a dependent claim depending on independent claim 1, claim 12 is a dependent claim depending on claim 11, and claim 22 is a dependent claim depending on independent claim 21. Applicant has already demonstrated claims1, 11, and 21 to be in condition for allowance. Applicant respectfully submits that claims 2, 12, and 22 are also allowable, at least by virtue of their dependency on allowable claims.

III. 35 U.S.C. §103, Alleged Obviousness, Claims 3, 5, 8, 14, 17, 23, 25, and 28

The Examiner has rejected claims 3, 5, 8, 14, 17, 23, 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Admitted Prior Art* in view of *Eerola* (U.S. Patent No. 6,678,518). This rejection is respectfully traversed.

Applicant agrees with the Office Action that *Applicant's Admitted Prior Art* does not teach that the transcoding servlet obtains the client device characteristic information from the preamble servlet. *Eerola* does not provide for the deficiencies in *Applicant's Admitted Prior Art*. *Eerola* is similar to *Applicant's Admitted Prior Art* in that it *Eerola* does teach transcoding. However, the Examiner alleged that:

> As to claims 3, 5 and 8 . . . *Eerola* discloses transcoding servlet (26, fig. 2; servlet 26, fig. 2 is configured to perform content conversions; col. 4, lines 25-34) obtains the client characteristic information from the preamble servlet (i.e., servlets 22, 24, fig. 2 for processing the request based on the characteristics or parameters of the URL request; col. 4, lines 40-44) (i.e., servlet 24, fig. 2 sends a MIME header containing information indicating the content type . . . appropriate servlet (transcoding servlet) is invoked to convert the indicated content type to another content type, desired or required by a user; col. 4, lines 49-56).

(*Office Action*, dated October 1, page 5).

As discussed above in regards to independent claims 1, 10, and 11, *Eerola* does not teach the storage or usage of client device character information for transcoding content data, as recited in independent claim 1, upon which dependent claims 3, 5, and 8

are dependent. Therefore, *Eerola* does not "disclose transcoding servlet obtains the client characteristic information from the preamble servlet."

Dependent claims 3, 5, and 8 are representative of dependent claims 14, 17, 23, 25, and 28 with respect to similarly recited subject matter. Claims 3, 5 and 8 are dependent claims depending on independent claim 1, claims 14 and 17 are dependent claims depending on claim 11, and claims 23, 25 and 28 are dependent claims depending on independent claim 21. (Claim 3 is directly dependent on dependent claim 2, which is dependent on independent claim 1. Claim 23 is directly dependent on dependent claim 22, which is dependent on independent claim 21.) Applicant has already demonstrated claims1, 11, and 21 to be in condition for allowance. Applicant respectfully submits that claims 3, 5, 8, 14, 17, 23, 25, and 28 are also allowable, at least by virtue of their dependency on allowable claims.

IV. 35 U.S.C. §103, Alleged Obviousness, Claims 7, 16 and 27

The Examiner has rejected claims 7, 16 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Admitted Prior Art* in view of *Eerola* (U.S. Patent No. 6,678,518). This rejection is respectfully traversed.

The Office Action alleges that *Applicant's Admitted Prior Art* discloses "wherein the client device characteristic information is obtained from a header of the HTTP request message (i.e., the request header includes information identifying the device type, user identification, passwords, URL requested, HTTP method used; specification, page 1, line 24 – page 2, line 8). (*Office Action*, dated October 1, 2004, page 6). But this allegation overlooks the specification's clear indication that the client device characteristic information in the "header data is passed by the webserver to the content generator process, but is not passed on to subsequent steps on the way to the requesting device, such as to the transcoding mechanism." (Specification, page 2, lines 4-8). This means that while the client device characteristic information is part of a HTTP request's header data, nothing subsequently obtains the client device characteristic information.

Claim 7, which is representative of dependent claims 16 and 27 with respect to similarly recited subject matter, specifies "wherein the client device characteristic information is obtained from a header of the hypertext transport protocol request

message." Because Applicant's *Admitted Prior Art* does not teach or suggest obtaining or storing client device characteristic information, it does not render claims 7, 16 or 27 obvious.

Additionally, claim 7 is a dependent claim depending on independent claim 1, claim 16 is a dependent claim depending on claim 11, and claim 27 is a dependent claim depending on independent claim 21. Applicant has already demonstrated claims1, 11, and 21 to be in condition for allowance. Applicant respectfully submits that claims 7, 16, and 27 are also allowable, at least by virtue of their dependency on allowable claims.

V. 35 U.S.C. §103, Alleged Obviousness, Claims 6, 9, 10, 15, 18, 19, 20 and 26

The Examiner has rejected claims 6, 9, 10, 15, 18, 19, 20, and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Admitted Prior Art*. This rejection is respectfully traversed.

Claims 6, 9, and 10 are dependent claims depending on independent claim 1, claims 15, 18, 19, and 20 are dependent claims depending on independent claim 11, and claim 26 is a dependent claim depending on independent claim 21. (Claim 9 is directly dependent on dependent claim 7, which is dependent on independent claim 1. Claim 18 is directly dependent on dependent claim 16, which is dependent on independent claim 11.) Applicant has already demonstrated claims1, 11, and 21 to be in condition for allowance. Applicant respectfully submits that claims 6, 9, 10, 15, 18, 19, 20, and 26 are also allowable, at least by virtue of their dependency on allowable claims.

VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 12/23/04

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